1. For Purposes of 35 U.S.C. § 102(e), The Effective Date of The Bennett Patent Is Its Filing Date of April 4, 1994

The claims relating to MKK3 have been rejected as obvious under 35 U.S.C § 103 over the Bennett patent (applied under § 102(e)) in view of Sambrook.[1] The face of the Bennett patent asserts a claim to the benefit of both PCT/US93/00586, filed January 22, 1993 (Avraham) and Application Serial No. 826,935, filed January 22, 1992 (collectively, "the Avraham applications"). However, the effective date of the Bennett patent for 35 U.S.C. § 102(e) purposes is its filing date of April 4, 1994.

Application Serial No. 826,935, filed on January 22, 1992, became abandoned on March 28, 1992 for failure to respond to the Office Action mailed December 28, 1992 (*see* the file history of Application Serial No. 826,935, Paper Nos. 11 & 12, copies enclosed for the Examiner's convenience). Thus, co-pendency with the Bennett application filed on April 4, 1994 (Application Serial No. 222,616) does not exist under 35 U.S.C. § 102(e) even though priority is also claimed to PCT/US93/00586, filed January 22, 1993. The mere filing of an international application, as was PCT/US93/00586, does not suffice as a filing date for purposes of 35 U.S.C. § 102(e). Instead, the filing date of an international application for purposes of 35 U.S.C. § 102(e) is the date on which paragraphs (1), (2) and (4) of 35 U.S.C. § 371(b) have been fulfilled; in other words, the date on which the national fee, a copy of the international application (in English), and an executed oath or declaration of the inventor(s) has been filed in the Patent & Trademark Office. *See* 35 U.S.C. § 102(e) and MPEP Section 1893.03(b).

In addition, even if co-pendency of the application that issued as the Bennett patent with the Avraham Application Serial No. 826,935, filed January 22, 1992 could be established (for instance, with another co-pending application), the Bennett patent would still be entitled only to its filing date of April 4, 1994 for 35 U.S.C. § 102(e) purposes. An issued patent is a reference under 35 U.S.C. § 102(e) if

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[1] Although the Office Action states that claims 49-52 and 55 are anticipated under 35 U.S.C. § 102(e) (page 4, line 3), Applicants presume from the remainder of the text of the rejection that the Bennett patent was applied as a reference for obviousnessness purposes. Regardless, Applicants submit that the rejection has been addressed and obviated by the discussion above.

> (e) the invention was described in a patent ***granted on an application*** for patent by another filed in the United States before the invention thereof by the applicant for patent. . . (emphasis added).

An examination of the file of the Bennett patent makes clear that the Bennett patent was only ***granted on*** the Application Serial No. 222,616, filed April 4, 1994.

In order to claim the benefit of priority of an earlier filed application, an alleged continuation-in-part application must comply with the formal requirements of 35 U.S.C. § 120, including, *inter alia*, that the first application and the alleged continuation-in-part application were filed with at least one common inventor. MPEP § 201.08. The named inventors on the prior filed Avraham applications (PCT/US93/00586 and Application Serial No. 826,935) were Hava Avraham, Jerome Groopman, Sally Cowley and David Scadden. None of these individuals was named as an inventor on the Bennett application. The Bennett application was filed with named inventors Brian Bennett, David Goeddel, William Matthews, James Lee, Siao Ping Tsai and William Wood, while the named inventors on the issued Bennett patent were Brian Bennett, David Goeddel, William Matthews. Therefore, the Bennett patent is not entitled to claim priority to PCT/US93/00586 and Application Serial No. 826,935, and accordingly, the Bennett patent was not "granted on" these applications.

Indeed, not only was the Bennett patent not entitled to claim priority to the Avraham applications, but Avraham (PCT WO 93/15201) was used as a reference in a prior art rejection of the claims in the Bennett application. In asserting the rejection, the Examiner of the Bennett application ***explicitly*** noted that priority to the Avraham applications was not justified. She stated:

> Note that although WO 93/15201 is the published version of PCT/US93/00586 to which applicant claims priority, the effective filing date of the claimed invention is the filing date of this application. This is because, there is no mention of antibodies which bind to the extracellular portion of HTK. This taken with the fact that the inventors on the world patent application are different from the instant invention makes this reference prior art under 35 U.S.C. 103.

File History of U.S. Application Serial No. 08/222,616, Office Action mailed April 19, 1995, Paper No. 9, page 10 (emphasis omitted). For the Examiner's convenience, a copy

of this paper is enclosed with this response. This statement by the Examiner went uncontested by applicants for the Bennett patent.

Thus, the Bennett patent was clearly "granted on" only Application Serial No. 222,616, filed April 4, 1994. Hence, the effective date of the Bennett patent under 35 U.S.C. § 102(e) is April 4, 1994.

Finally, even if a patent is "granted on" Application Serial No. 826,935, this application does not contain the sequence of the full length LpTK 2 clone described in Figure 5 of the Bennett patent. Instead, Application Serial No. 826,935 contains only a partial sequence of this clone (see Figure 3 of Application Serial No. 826,935) that does not anticipate or render obvious the full length MKK3 protein or, for that matter, a polypeptide containing more of the MKK3 amino acid sequence than the disclosed amino acid sequence.

2. The Bennett Patent and Avraham Are Not Available As Prior Art Against The Claims

As noted above, the effective date of Bennett as a reference under 35 U.S.C. § 102(e) is April 4, 1994. The publication date of Avraham is August 5, 1993. Assuming arguendo that the subject matter of any of the references did indeed make obvious the MKK3 polypeptides of the claimed invention, Applicants contend that neither reference is available as prior art.

To support their contention, Applicants submit a Second Declaration by the Inventors under 37 C.F.R. § 1.131. Although this declaration is signed by only one of the co-inventors, Applicants will supply a copy of the Declaration signed by each inventor as soon as practicable. This declaration is evidence that, prior to January 28, 1994, the Applicants had conceived of the invention and were duly diligent in reducing it to practice and/or actually reduced it to practice in the United States by introducing the complete coding sequence of human MKK3, as well as a cloned plasmid containing the isolated polynucleotide encoding MKK3. Thus, prior to the April 4, 1994 effective date of the Bennett patent under 35 U.S.C. § 102(e), Applicants have shown completion of the claimed invention commensurate in scope with the extent the invention is allegedly shown in the Bennett patent.

This declaration is also evidence that, prior to August 5, 1993 (the effective date of Avraham), the Applicants had possession in the United States of at least as much of the

subject matter of the claimed invention as is described in Avraham. In particular, Applicants had introduced the complete coding sequence of human MKK3 into the United States. *In re Moore,* 170 USPQ 260, 267 (CCPA 1971) (A Rule 131 Declaration need not show more *acts* than could be performed by one of ordinary skill informed by the reference). *In re Stempel,* 113 USPQ 77 (CCPA 1957) (applicant must show "priority with respect to so much of the claimed invention as the reference happens to show"). Thus, prior to the August 5, 1993 effective date of Avraham, Applicants have shown completion of the claimed invention commensurate in scope with the extent the invention is allegedly shown in Avraham.

In view of these declarations, the Bennett patent and Avraham cannot be considered prior art under 35 U.S.C. §§ 102(e)/103(a) and 103(a), respectively. Therefore, Applicants respectfully request withdrawal of all of the rejections in view of these references.

CONCLUSION

Entry of the foregoing remarks into the file of the above-referenced patent application is respectfully requested. Applicants believe that each ground for rejection and objection has been successfully overcome or obviated and that the claims are in condition for allowance. If any issues remain in connection with this application, Applicants encourage the Examiner to call the undersigned collect at (212) 790-9090.

No additional fee is believed to be due with this Amendment. However, the Commissioner is hereby authorized to charge any fees associated with this Amendment to Pennie & Edmonds LLP Deposit Account No. 16-1150. A copy of this sheet is enclosed.

Respectfully submitted,

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Date: November 24, 1999

for Laura A. Coruzzi 30,742

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Enclosures